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EXAMINER

PARKER, BRANDI P

ART UNIT

PAPER NUMBER

3624

MAIL DATE

DELIVERY MODE

12/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/679,255	Applicant(s) MANN ET AL.	
	Examiner BRANDI P. PARKER	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/20/2008</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The following is a Second Non-Final Office action in response to communications filed on 10/20/2008. Claims 1-27 have been examined, claims 1-14 have been amended, claim 15 has been withdrawn and claims 16-27 are newly added.

Response to Applicant's Remarks

2. In response to Applicant's argument that claims 9-14 comply with the requirements of 35 U.S.C §112 first and second paragraph, Examiner respectfully disagrees.

In particular, the specification and claims fail to adequately define and/or describe how to arrive at a value corresponding to the variables that are used in the respective metric equations, such as: Links(confirmed), importance, half links, Impact, importance, etc. Furthermore, the same variables are defined differently for each claim. The issue is not the interpretation and application of straightforward mathematical expressions that may be readily understandable by one with a modest level of mathematical expertise below one of ordinary skill in the art. The thrust of Examiner's argument is that a definition and description of each variable, as well as how to

Art Unit: 3624

determine each variable is required to adequately describe the invention, and is lacking in Applicant's specification. Therefore, the rejection of claims 9-14 under 35 U.S.C §112 first and second paragraph was not in error and is thus sustained.

3. Applicant's arguments with respect to claims 1-8 and newly added claims 16-21 have been considered but are moot in view of the new ground(s) of rejection.

Requirement for Information

4. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

5. Examiner has reviewed the claims and would like to know where, specifically, the mathematical equation presented in claims 9-14 and 22-27 came from. Specifically, Examiner requests that the Applicant provide references to textbook(s), publication(s), etc. where the equation of claims 9-14 and 22-27 can be found, with specific citations to the relevant passages. If the equations are derived from existing equations, Examiner would like to know where the existing equations can be found.

6. The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. In the preamble of claim 1, applicant claims a combination within a system. A combination is not within any of the statutory classes of inventions. Examiner would like to remind the applicant that the statutory classes consist of a process or method, machine or apparatus, manufacture, or composition of matter.

Art Unit: 3624

10. Furthermore, in claim 1, applicant attempts to claim software per se. Claim 1 discloses multiple means for defining the status of components, obtaining input data and quantifying agreements without any corresponding structure provided in the claim or specification. The specification fails to provide any structure, machine or apparatus associated with the above means. Specifically, Examiner cites page 5 of the specification where Applicant disclosed "All of the above and other features of the invention are facilitated by appropriate software for providing/enabling the functions in the illustrated and equivalent embodiments to "make it happen" in achieving new and improved business analysis and management systems utilizing enterprise metrics". Therefore, claim 1 is non-statutory and therefore rejected under 35 U.S.C. 101.

11. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

12. Whether a method appropriately includes particular machines to qualify as a section 101 process may not always be a straightforward inquiry. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of

Art Unit: 3624

the mental process may not make the claim patentable subject matter." *In re Comiskey*, 499 F.3d 1365, 1380 (Fed. Cir. 2007), (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (BPAI 2008-1495, 2008).

Claim 2 is directed towards predictive organizational performance. As the claims are not sufficiently tied to an apparatus, such as a computer, and/or do not transform the underlying subject matter (from your claim) to a different state, the claimed method is non-statutory and therefore rejected under 35 U.S.C. 101. Furthermore, the specification fails to provide any structure, machine or apparatus associated with the above method, and disclose that software is the main operational component.

13. Claims 3-14 and 16-27 are rejected for being dependent upon rejected claims 1 and 2 respectively.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. Claims 9-14 and 22-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

16. Claims 9-14 and 22-27 contain mathematical formulas that compute the quantitative values for metrics that monitor organizational change and improvement. However, the specification fails to describe or define the formula components in a way to enable one skilled in the art to make and use the invention as defined by the claims. Appropriate correction is required.

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 1, 3-14, and 22-27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3624

19. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993).

20. Claims 1 and 3-14 recite a "combination" as set forth in either claims 1 or 2. It is unclear as to what applicant claims (i.e. processor or method, apparatus or system). Appropriate correction is required.

21. Furthermore, claim 1 describes multiple means, as well as disclose method steps (i.e. benchmarks for measuring, predicting and enhancing various aspects for the organization). A single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention. *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)

22. Claims 9-14 and 22-27 contain mathematical formulas that compute the quantitative values for metrics that monitor organizational change and improvement. However, the claims fail to describe or define the formula components in a way to distinctly point out and distinctly claim Applicant's invention. Appropriate correction is required.

Specification

23. It appears that Applicant attempted to incorporate essential material in the specification by reference to Exhibits A-H. The incorporation of essential material into the specification by way of an unpublished U.S. application, foreign application or patent, or to a publication is improper. Thus, Applicant's attempt to incorporate subject matter into this application by reference to Exhibits A-H is ineffective because the exhibits contain materials that are essential to understanding the formulas for the various metrics for the tool characteristics.

24. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating

Art Unit: 3624

that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

25. Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). MPEP 608.01(p) I A. 37 CFR 1.57(b)(1) limits a proper incorporation by reference (except as provided in 37 CFR 1.57(a)) to instances only where the perfecting words "incorporated by reference" or the root of the words "incorporate" (e.g., incorporating, incorporated) and "reference" (e.g., referencing) appear.

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 1-8, 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Townsend (6631473) in view of EnCompass Knowledge Systems, Inc.

28. With respect **to claims 1 and 2**, Thompson teaches the system and method comprising:

- a. means defining the status of complex system/organization components in terms of issues and relationships (column/line 3/5-12);
- b. third means for quantifying the agreement among various system/organizational components relative to selected systems/organizational tool characteristics (column/line 3/55-62)
- c. whereby benchmarks are established for orienting and/or monitoring system/organization change and improvement for measuring, predicting and enhancing various aspects of the organization (column/line 4/3-7).

Townsend does not directly teach obtaining input data from participants in an organization regarding their perceptions. However, EnCompass teaches

- i. said first means including a second means for obtaining input data from participants in an organization regarding their perception of the significance of their interaction with others on particular issues and/or relationships within the organization (page 1); and
- ii. reflecting the interactive perspective of individuals relative to each other on said issues and relationships (page 1).

It would have been obvious to one of ordinary skill in the art to include the business system of Townsend with the ability to obtaining input data from participants in an organization regarding their perceptions as taught by EnCompass since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

29. As to **claims 3 and 16**, Townsend teaches wherein said tool characteristics include: a metric for "CLARITY" (column/line 6/40-45).

30. Regarding **claims 4 and 17**, Townsend teaches wherein said tool characteristics include: a metric for "INVOLVEMENT" (column line 6/49-62).

31. With respect to **claims 6 and 19**, Townsend teaches wherein said tool characteristics include: a metric for "PRIORITY" (column/line 4/43-46, 4/56-5/18).

Art Unit: 3624

32. As to **claim 7 and 20**, Townsend teaches wherein said tool characteristics include: a metric for "RELATIVE PRIORITY" (column/line 4/46-49).

33. Regarding **claim 8 and 21**, Townsend teaches wherein said tool characteristics include: a metric for "INTEGRATION" (column/line 7/1-37).

34. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Townsend (US 6631473) in view of Hambrick et al (US 5671360).

35. With respect to **claims 5 and 18**, Townsend teaches the calculation of various metrics using mathematical algorithms (column/line 4/43-5/18; column 6, lines 40-62; column 7, lines 1-37). Townsend does not explicitly teach a tool characteristic including a metric for "LEVERAGE". However, Hambrick teaches wherein said tool characteristics include: the authority metric "LEVERAGE" (column/line 8/22-38).

It would have been obvious to one of ordinary skill in the art to include the business system of Townsend in view of EnConpass that leverages the time and knowledge of participants of an organization with the ability to calculate a leverage metric as taught by Hambrick since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDI P. PARKER whose telephone number is (571) 272-9796. The examiner can normally be reached on Mon-Thurs. 8-5pm.

37. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley B. Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

38. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRANDI P PARKER/
Examiner, Art Unit 3624

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624